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EXAMINER

LEE, Y'MY QUACH

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/801,177
Filing Date: March 15, 2004
Appellant(s): BELLIVEAU, RICHARD S.

Donald R. Dunner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 21, 2008 and November 21, 2008
appealing from the Office action mailed January 3, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of no amendments after the latest rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. However, the summary of the embodiment figure 3F of the patent '893 as well as the subject matter of the original prosecution claims and the non original claim added in the reissue directed to embodiment figure 3F is partially incorrect.

Part B, page 11, lines 18 to 20 and page 13, lines 2 to 4 of the brief, Appellant states that figure 3F illustrates discrete circuits for individually controlling the wavelength intensity of the light sources. This is inaccurate. Embodiment figure 3F discloses discrete circuits for individually controlling the light source intensity. Embodiment figure 3F neither discloses different color light sources nor illustrates discrete circuits for individually controlling the

wavelength intensity of the light sources. Individually controlled different wavelength intensities of the light sources are disclosed in the non elected embodiments of figures 3D and 3E of the patent '893, note column 12, lines 1 to 47 of the patent.

Part B, page 13 of the brief, Appellant states that the Examiner considered claims 19, 20, 33 to 36, 37, 39 to 40, 43 and 49 of the original application '499 to be directed to non elected subject matter on the basis that they contained above and beyond LEDs with individually controllable wavelength intensity – at least one additional limitation illustrated by a Figure of Non Elected groups 2, 3 or 4. This is inaccurate, claims 37 and 39 are directed to the non elected subject matter of the embodiment in figure 3D and/or 3E, there are no additional limitations contained above and beyond the LEDs individually controllable wavelength intensity in these claims.

Part E, page 25, lines 14 to 16 of the brief, Appellant states that the non original claim 78 added in the reissue application covers subject matter from Elected Group 1 of application '499 because it is directed to the embodiment illustrated in figure 3F and relies upon column 10, line 65 to column 11, line 9 of patent '893 to support the claimed subject matter directed to figure 3F. This is inaccurate because claim 78 is not directed to figure 3F. Embodiment figure 3F discloses discrete circuits for individually controlling the light source intensity. Embodiment figure 3F neither discloses different color light sources nor illustrates discrete circuits for individually controlling the wavelength intensity of the light sources. Although column 11, lines 3 to 6 of the patent '893 describe that the circuit could be advantage when providing control access to multi color systems or different intensity levels of each specific color, this general description however does not indicate that the light sources of embodiment figure 3F are colored, emit or produce

different colors. Individual controlled different wavelength intensities of the light sources to produce different colors or wavelengths intensities respectively are clearly disclosed in the non elected embodiments of figures 3D and 3E, note column 12, lines 1 to 47 of patent '893.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. However, the statement on lines 4 to 8 of the third full paragraph of page 29 of the brief is incorrect.

Page 29, lines 4 to 8 of the brief, Appellant states that the Examiner considered claims 20 to 22 and 39 as well as claims 33 to 37, 40, 43 and 49 of the original prosecution to be directed to non elected subject matter on the basis that they contained at least one limitation illustrated in a Figure of Non Elected Groups 2, 3 or 4 and not on the basis that they contained subject matter directed to LEDs with individually controllable wavelength intensity. This is inaccurate because claims 37 and 39 were restricted because they contain subject matter directed to the LEDs or light sources with individually controllable wavelength intensity that are disclosed in the non elected embodiments of figures 3D and 3E.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 to 82 are rejected as being based upon a defective reissue oath or declaration under 35 U.S.C. 251 for lack of error. The reissue oath/declaration filed with this application is defective (see MPEP 1414) because the error attempted to be corrected is not the type of error that is correctable through reissue, the requirement under U.S.C. 251 therefore has not been met.

(10) Response to Argument

Appellant argues that the reissue claims on appeal are substantially different from the non elected claims that were cancelled during the original prosecution of the '893 patent because they contain significant additional limitations not present in any of the non elected claims, and that the reissue claims could have been prosecuted alongside the elected claims since reissue claims 13 to 77 and 79 to 82 are linking claims covering subject matter from both Elected group 1 (original prosecution application '499) and at least one of Non-Elected groups 2 to 4 (original prosecution application '499) and claim 78 covering only subject matter of the Elected group (original prosecution application '499). Appellant has found that In Doyle 293 F.3d at 1361, the Federal Circuit held that the failure to prosecute claims following issuance of a restriction requirement is an error correctable by reissue if the claims are substantially different from the non-elected claims during the original prosecution and the reissue claims could have been prosecuted alongside the claims of the elected group, in particular, the court held that the failure to present a "linking claim" in the circumstances outlined above is an error correctable by reissue. Appellant states that because the requirements of Doyle are met, Appellant mandates reversal of the

Examiner's rejection of pending claims 1 to 82 and believes that the proper course is to issue a restriction requirement under 37 C.F.R. 1.176(b).

It should be noted that MPEP 1412.01 Page 1400-17 August 2005 states that a *linking claim*, according to In Re Doyle, is a claim broad enough to read on the invention elected (*and patented*) together with the invention not elected.

In the original prosecution of the patent under reissue, the elected species of figures 2A, 2B, 3A to 3C and 3F is directed to a flashlight having a thread holder with internal grooves threaded or screwed onto the threads mounted on a case to adjust the variable force or pressure, applied by a battery cell, on a flexible substrate having light emitting diodes mounted thereon to cause the substrate to deform in a first state and to not deform in a second state to change the direction of the concentration of the light emitted by the light emitting diodes of which the light intensity can be individually controlled by the discrete circuits are mutually exclusive from other non elected species of figures 3D, 3E, 4(A-C), 5(A-C), 6(A-C), 7(A-C), 8(A-C), 9(A-B) and 12(A-C).

Newly added claims 13 to 82 in the reissue application include a plurality of different wavelengths light emitting diodes such as yellow, amber, red, blue, green, white, first ultraviolet color or second ultraviolet color light emitting diodes mounted on a curve substrate, a lamp driver, a communication component comprising a processor receiving a control command, a first housing pan and tilt in relation to a second housing by a motor caused by a remote control, a communication line providing a control signal, a fan, ventilation holes, a variable filter such as a liquid crystal emulsion filter and a control command varying the optical state of the filter are drawn to the non-elected species of figures 3D, 3E, 4(A-C), 5(A-C), 6(A-C), 7(A-C), 8(A-C),

9(A-B) and 12(A-C) that are mutually exclusive from the elected species as defined in patent claims 1 to 12.

In view of the subject matter claimed in the patent claims and the subject matter claimed in the reissue claims, these newly added reissue claims are not broad enough to read on meaning generic to the invention elected (and patented) together with the invention not elected, these reissue claims are therefore not analogous to the linking claims according to *In re Doyle*. MPEP 1412.01 Page 1400-17 August 2005. Accordingly, the requirements of *Doyle* are not met.

Appellant also argues that the restriction requirement in the original prosecution application '499 was based on the figures of the Application but was not based on the LEDs with individually controllable wavelength intensity to be directed to non elected subject matter.

It should be noted that the subject matter of individual controllable wavelength light intensity was restricted in the original prosecution application because this subject matter was directed to non elected embodiments 3D and/or 3E in view of the non elected claims 37 and 39 of application '499.

With regards to the arguments regarding the reissue claims 13-17 and 79-82 that could have been prosecuted alongside the elected claims since they contain significant additional limitations not present in any of the non elected claims of the original application '499 and that no formal restriction requirement was issued with respect to claims drawn to combinations of the limitations identified in the reissue claims, as such, claims were not presented in Appellant's original application, Appellant relates *Ex Parte Okamoto* to argue that the appellants' failure to

file a divisional application to such subject matter was not a deliberate act and was an error under Section 251.

It should be noted that if these added reissue claims were presented during the prosecution of the '499 application, these claims would have been restricted out as being directed to an invention that is patentably distinct from the elected invention, and these claims would have been withdrawn from consideration as being directed to a non-elected invention. Since failing to file a divisional application, Appellant lost his right to claim any subject matter other than the claimed invention as patented by electing the species of figures 2A, 2B, 3A to 3C and 3F. MPEP 1412.01 Page 1400-19 September 2007. Appellant cannot now undo the election by contending, on the present record, that the reissue claims contain significant additional limitations not present in any of the non elected claims and as such claims were not presented in Appellant's original application, and his failure to include these newly added claims was due to an "error". Accordingly, failure to present these added claims in the original prosecution cannot be considered an error that supports reissuance of the patent within the meaning of 35 USC 251, first paragraph. In addition, U.S.C. § 251 particularly limits, through the "error" requirement, which types of errors are correctable by reissue. Defects in the specification, drawings or claims which render the patent wholly or partly inoperative or invalid may be corrected. However, with respect to the correction of defects in claims, the patent must be "deemed wholly or partly inoperative or invalid ... by reason of the patentee claiming more or less than he had a right to claim in the patent". In other words, limitations can be added or removed from a claim to expand or contract its subject matter so it matches what patentee had a right to claim in the original patent to correct the defect in the claim which renders the patent wholly or partly

inoperative or invalid rather than the limitations that are not substantially similar to the original non elected claims or significant additional limitations not present in any of the non elected claims to avoid being restricted from during the original prosecution of the application and to pursue them now in a reissue application. Allowing Appellant to use the reissue statute to avoid a restriction/election requirement in which he acquiesced would defeat the purpose behind the copendency requirement of §§ 120 and 121 of the statute. Further, reissue statute was not enacted for correcting the original patent because of failing to prosecute the types of claims as argued or all patent prosecution problems. The “error” attempted to be corrected here is simply not the type of error that is correctable through reissue.

With respect to the argument regarding claim 78 added to the reissue application covering subject matter from elected group 1 and is therefore the proper subject of a reissue application, Appellant states that claim 78 is directed to the embodiment illustrated in Figure 3F in which there are discrete circuits which allow for varying the intensity of individual LEDs or different portions of LEDs ('893 Patent, column 10, line 65 to column 11, line 9).

It should be noted that claim 78 does not read on the embodiment of figure 3F because figure 3F does not disclose that the light emitting diodes emit light of first, second, third, fourth and fifth wavelengths, respectively and that these first, second, third, fourth, and fifth wavelengths produce respectively different colors. Although column 11, lines 3 to 6 describe that the circuit could be advantage when providing control access to multi color systems or different intensity levels of each specific color, this general description however does not indicate that the light sources of the embodiment figure 3F are colored, emit different wavelengths or produce different wavelengths nor does it show that the multicolor systems are

referring to the light sources system of Figure 3F. As previously stated, individual or different wavelength light sources controlled intensity is fully described in the nonelected embodiments of figures 3D and 3E, column 12, lines 1 to 47 of the patent '893. Accordingly, claim 78 does not cover subject matter from elected group 1 and is therefore not the proper subject of a reissue application.

With respect to the arguments regarding if the reissue claims 13 to 82 are divisible from the elected claims, the proper course is a restriction requirement, not a rejection, Appellant states that if the Examiner concludes that the pending reissue claims are indeed directed to a separate and distinct invention, the Examiner is free to issue a restriction requirement between the originally issued patent claims 1 to 12 and the reissue claims 13 to 82, the original patent claims will then be held to be constructively elected, while the none elected newly added reissue claims are held in abeyance in a withdrawn status and only examined if filed in a divisional reissue application pursuant to 37 CFR 1.177.

Note that the suggestion of the restriction is premature at this time pending on decisions of the issues before the board.

(11) Related Proceeding(s)

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Y M Lee/
Primary Examiner, Art Unit 2885

Conferees:

Clayton Laballe

/J. L./
Supervisory Patent Examiner, Art Unit 2885